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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,083	12/08/2006	Claus Permesang	BE-172PCT	4320
40570	7590	12/07/2010		
Lucas & Mercanti LLP 475 Park Avenue South New York, NY 10016			EXAMINER LAUX, JESSICA L.	
			ART UNIT 3635	PAPER NUMBER
			MAIL DATE 12/07/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/577,083

**Applicant(s)**

PERMESANG, CLAUDE

**Examiner**

JESSICA LAUX

**Art Unit**

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4 and 6-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 6-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Acknowledgment is made of the amendment filed 9/27/2010. Accordingly the specification, drawings and claims have been amended.

#### ***Response to Arguments***

Applicant's arguments filed 9/27/2010 have been fully considered but they are not persuasive.

Applicant's argument that Miller et al. does not disclose a bordering that fills open joints on the visible side of the building component are not persuasive. Miller discloses a bordering of adhesive 24 which is applied on elements 21,22 which are part of the visible upper surface and coating element making up the upper layers 17-19 (see below). Therefore Miller does disclose a bordering as claimed.

Applicant's argument that the adhesive layer between 16 and 17-19 of Miller is not equivalent to the claimed layer because the thicknesses vary is not persuasive. The thickness of the layer is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, as presently claimed, the adhesive layer of Miller anticipates applicant's adhesive layer and therefore the claim. Applicant's remark that the device of Miller et al cannot be produces by foaming or spraying on in a molding cavity is mere conjecture unsupported by fact or evidence and is therefore insufficient to overcome the preponderance of evidence supporting the rejection.

Applicant's argument that the adhesive intermediate layer and the layer 24 are not integral is not persuasive as the layer 24 is disclosed as being applied to the entire coupling elements and would therefore be connected with and integral to the adhesive layer between 16 and 17-19.

Applicant's argument that that the adhesive layer is not the same material as the further layers 17-19 is not persuasive as the claim does not require the intermediate layer and the upper layer be of the same material. Instead the claim requires that the intermediate layer and the bordering be of the same material. Miller discloses that the intermediate layer and the bordering are both an adhesive and therefore are the same material.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., an adhesive layer so thick it is produced in a molding tool) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1,4,6-11,13-17,19-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Miller et al (20040031226).**

Claims 1, 4, 6, 10,16, 19-21. Miller et al discloses a flexible building component for forming floor and/or wall coverings, comprising: a support layer (16) for placement on a floor or a wall to be covered; an upper layer (17-19) including at least one coating elements (any one of 17-19) and forming a visible upper surface of the building component; an intermediate layer (the adhesive layer of paragraph 0020) arranged between and connecting the support layer and the upper layer; elastic joint devices (21,22) for connecting the building component to similar building components and/or edge facing elements applied to a floor or a wall; and a bordering (24) encircling the building component and filling open joints at the visible upper surface between the at least one coating element of the building component and a coating element of a further building component, wherein the width of the bordering encircling the building component is half as wide as the width of the joints between several coating elements (where the joint includes one element 21 and one 22 each having a layer 24 therefore the bordering element 24 is half the width of the joint as the joint comprises two borders 24); wherein: the intermediate layer is foamed or sprayed on the support layer and the at least one coating element (paragraphs 0032, 0036, 0038 disclose applying the chemical adhesive glue by spray foam to provide an precise and accurate dispersion of the glue) so as to simultaneously form a bordering integrally connected to the intermediate layer and encircling the building component (where the adhesive is also on

the coupling parts as a preglue, element 24 and extends completely around the coupling parts thereby being connected to the intermediate layer), which bordering is of the same material as the intermediate layer (an adhesive as disclosed by Miller et al) wherein the support layer and the coating element are positioned at a distance relative (where they are spaced by the adhesive layer) to each other.

It should be noted that the limitations of "foamed or sprayed" and "in a molding cavity of a tool" are considered product-by-process limitations. The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985).

In the instant case Miller does disclose applying the adhesive by spraying as noted above, but does not necessarily disclosed the process of being disposed in a tool and spaced by a molding cavity, however the prior art product does have a support layer spaced from a coating element by an intermediate layer that is spray foamed on. Therefore the prior art product is the same as Applicant's claimed invention and thus the product is anticipated by the prior art.

Claim 7. The building component according to claim 1, wherein the intermediate layer is made of an elastic and/or water-resistant material (paragraphs 0040-0048).

Claim 8. The building component according claim 1, wherein the support layer is made of recycling material (paragraph 0021).

Claim 9. The building component according to claim 1, wherein the coating element is made of ceramic, stoneware, natural stone, glass, plastic, metal and/or wood (paragraphs 0022-0024).

Claim 11. The building component according to at claim 1, wherein the devices for connecting are connector devices (20, 22) for tongue-and-groove joints.

Claim 13. A building component according to claim 10, wherein engaging connector devices are provided (as seen in figures 2-3, particularly at elements 21,23).

Claim 14. The building component according to claim 11, wherein the groove is formed between the support layer and the layer encompassing the coating element (as seen in the figures).

Claim 15. The building component according to claim 10, wherein the edges of the support layer and of the layer encompassing the coating element are arranged offset relative to each other, parallel to the plane of the support layer (as seen in figure 2).

Claim 17. The building component according to claim 1, wherein the support layer has a surface profile (as seen in the figures).

Claim 22. The building component according to claim 1, wherein the building component is curved as a whole and/or exhibits a curved surface (at 23).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over  
Miller et al (20040031226) in view of Miller et al (20030208980).**

Claim 12. Miller et al. ('226) discloses the building component according to claim 11, where a tongue is formed opposite a groove, however Miller et al ('226) does not disclose that a tongue and groove are formed at two sides respectively. Rather Miller et al. ('226) discloses that a tongue and groove are formed at one side.

Miller et al. ('980) discloses a building component having layers and a tongue formed opposite a groove, where the groove is at two adjacent perpendicular sides and the tongues are opposite the grooves (figure1).

At the time the invention was made it would have been obvious to one having ordinary skill in the art to modify the component of '226 to have two perpendicular sides with a groove and the opposite sides with a tongue to improve the connection between adjacent placed building components by having a connection on all sides of the component.

**Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over  
Miller et al (20040031226) in view of Milborn (2548036).**

Claim 18. Miller et al. discloses the building component according to claim 1, but does not disclose pipes for a heating and/or cooling, heating conductors and/or sensors are embedded in the building component in the support layer.

Milborn discloses a panel for use in flooring having layers and pipes disposed in a support layer for heating a floor made of the panels (see figures; disclosure).



At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the panel of Miller et al. to have the pipes as disclosed by Milborn to incorporate heating/cooling into the building component to provide efficient and space-saving thermal elements to a building.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **JESSICA LAUX** whose telephone number is (571)272-8228. The examiner can normally be reached on Monday thru Thursday, 9:00am to 5:00pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen Lillis can be reached on 571-272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eileen Lillis/  
Supervisory Patent Examiner,  
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